IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Attorney Docket No.: **Google-35APP (GP-090-00-US)**

Appl. No.: **10/748,870**

Applicants/Appellant: **Jeffrey A. DEAN, et al.**

Filed: **December 29, 2003**

Title: **IDENTIFYING RELATED INFORMATION GIVEN CONTENT AND/OR PRESENTING RELATED INFORMATION IN ASSOCIATION WITH CONTENT-RELATED ADVERTISEMENTS**

TC/A.U.: **2178**

Examiner: **Wilson W. Tsui**

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S I R:

APPEAL BRIEF

Further to the Notice of Appeal filed on March 28, 2007, which set a period for response to expire on May 28, 2007, that period being extended three (3) months to expire on August 28, 2007 the Appellant requests that the Board reverse all outstanding grounds of rejection in view of the following.

I.   Real Party In Interest

The real party in interest is Google, Inc. An assignment of the above-referenced patent application from inventors Jeffrey A. Dean and Krishna Bharat to Google, Inc. was recorded in the Patent Office starting at Frame 0155 of Reel 016898. An assignment of the above-referenced patent application from inventor Paul Buchheit to Google, Inc. was recorded in the Patent Office on August 18, 2007 starting at Frame 0493 of Reel 019719.

II.   Related Appeals and Interference

There are no related appeals or interferences.

III.   Status of Claims

Claims 1-20 are pending.

Claims 1-20 are rejected. Specifically, Claims 7, 15 and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,804,659 ("the Graham patent"). Claims 1 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Graham patent. Claims 2, 10 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Graham patent in further view of U.S. Patent No. 6,505,169 ("the Bhagavath patent") and Edmunds.com, page 1, January 22, 2001 ("the Edmunds page"). Claims 3, 8, 11, 16 and 18 are rejected

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under 35 U.S.C. § 103(a) as being unpatentable over the Graham patent in further view of the Bhagavath patent and CNET.com, page 1, December 7, 2001 ("the CNET page"). Claims 4, 12 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Graham patent and the Bhagavath patent in further view of MSN.com, page 1, December 7, 2002 ("the MSN page"). Claims 5 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Graham patent in further in view of U.S. patent No. 6,006,225 ("the Bowman patent"). Claims 6 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Graham patent in further view of U.S. Patent Application Publication No. US2004/0093558A1 ("the Weaver publication").

The rejections of claims 1-20 are appealed.

IV.   Status of Amendments

There have been no amendments subsequent to the final Office Action (Paper No. 20061012).

V.   Summary of the Claimed Subject Matter

Independent claim 1 recites a method for combining various content for presentation to a user. (This is supported, for example, by Figures 2 and 5; page 13, line 1 through page 14, line 13; and page 15, lines 12-28.) The method includes (a) accepting ad document information (This is supported, for example, by 210 of Figure 2; page

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13, lines 5-7; 510 of Figure 5; and page 15, lines 15-19.); (b) using the ad document information to determine content in addition to content of the ad document (This is supported, for example, by 220 of Figure 2; page 13, lines 7-11; page 13, line 17 through page 14, line 13; 520 of Figure 5; and page 15, lines 15-19.); and (c) combining at least a portion of content of the ad document and at least a portion of the determined content for presentation to a user together with page content (This is supported, for example, by 240 of Figure 2; page 13, lines 12-16; 552, 554 and 556 of Figure 5; and page 15, lines 19-28), wherein the ad document is at least one ad (This is supported, for example, by 510 of Figure 5; and page 15, lines 15-19.), and wherein the page content is not directly used to determine the determined content (This is supported, for example, by Figure 5; and page 15, lines 15-24.)

Corresponding independent apparatus claim 9 recites an input for accepting ad document information, and corresponding means for performing the acts of determining and combining recited in the method of independent claim 1. The input is supported, for example, by 830 and 832 of Figure 8, and page 18, line 12 through page 19, line 19. The means are described, for example, by 810 of Figure 8, and page 18, line 12 through page 19, line 19. Exemplary apparatus for performing various acts and storing information generated or used by the present invention are supported, for example, by 160 of Figure 1; page 12, lines 27-30; Figure 8; and page 18, line 12 through page 19, line 19.

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Independent claim 7 recites a method for combining various content for presentation to a user. (This is supported, for example, by Figures 2 and 7; page 13, line 1 through page 14, line 13; and page 16, line 15 through page 18, line 10.) The method includes (a) accepting document information (This is supported, for example, by 210 of Figure 2; page 13, lines 5-7; 710 of Figure 7; page 16, lines 17 and 18; and page 17, lines 1-3.); (b) using the document information to determine content in addition to content of the document (This is supported, for example, by 220 of Figure 2, page 13, lines 7-11; page 13, line 17 through page 14, line 13; 720 of Figure 7; page 16, lines 19-25; and page 17, lines 1-33.); (c) using the determined content, determining further content (This is supported, for example, by 230 of Figure 2; page 13, lines 11 and 12; 740 of Figure 7; page 16, lines 25 and 26; and page 17, line 35 through page 18, line 10.); and (d) combining at least a portion of content of the document, at least a portion of the determined content, and at least a portion of the determined further content for presentation to a user (This is supported, for example, by 240 of Figure 2; page 13, lines 12-16; 752, 754 and 756 of Figure 7; and page 16, lines 26-31.)

Corresponding independent apparatus claim 15 recites an input for accepting ad document information, and corresponding means for performing the acts of determining content, determining further content, and combining recited in the method of independent claim 7. The input is supported, for example, by 830 and 832 of Figure 8, and page 18, line 12 through page 19, line 19.

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The means are described, for example, by 810 of Figure 8,
and page 18, line 12 through page 19, line 19. Exemplary
apparatus for performing various acts and storing
information generated or used by the present invention
are supported, for example, by 160 of Figure 1; page 12,
lines 27-30; Figure 8; and page 18, line 12 through page
19, line 19.

Embodiments consistent with the present invention
may improve a user's Internet experience when the user is
to be presented with target content, such as content in a
user requested document for example, by presenting both
the target content and determined additional content.
Such additional information may be of interest to the
user. This fact may be used to improve the performance
of online ads. For example, in some embodiments
consistent with the present invention, the additional
content presented can be placed within an advertisement
(or near an advertisement, or otherwise presented in
association with an advertisement). In such embodiments,
the additional content should increase the likelihood
that the user will look at (or otherwise perceive) the
advertising material (or that the advertising material
will otherwise get the user's attention) because the
advertising area contains additional kinds of relevant
information -- not just ads. For example, the target
content might be an advertisement for a product, and the
additional content might be reviews or news stories about
the product.

The target content may be a Web page for example.
The additional content might be related suggested queries
(e.g. "Try a search for _____"), news articles (or

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excerpts or summaries thereof), reviews (or excerpts or summaries thereof), advertisements, etc. The additional content could be presented in various ways or forms. For example, the additional content may be presented as a suggested query, "related information," etc. Although an excerpt or summary of the additional content may be presented instead of the entire additional content, such an excerpt can be considered to be "additional content" itself.

VI.   Grounds of Rejection to be Reviewed on Appeal

The issues presented for review are whether (separately patentable groups of) claims:

7, 15 and 20 are anticipated, under 35 U.S.C.
§ 102(b), by the Graham patent;

1 and 9 are unpatentable, under 35 U.S.C. § 103(a), over the Graham patent;

2, 10 and 17 are unpatentable, under 35 U.S.C.
§ 103(a), over the Graham patent in further view the Bhagavath patent and the Edmunds page;

3, 8, 11, 16 and 18 are unpatentable, under 35 U.S.C. § 103(a), over the Graham patent in further view of the Bhagavath patent and the CNET page;

4, 12 and 19 are unpatentable, under 35 U.S.C. § 103(a), over the Graham patent and the Bhagavath patent in further view of the MSN page;

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5 and 13 are unpatentable, under 35 U.S.C. § 103(a), as being over the Graham patent in further in view the Bowman patent; and

6 and 14 are unpatentable, under 35 U.S.C. § 103(a), as being over the Graham patent in further view of the Weaver publication.

VII. Argument

The Appellant respectfully requests that the Board reverse the final rejection of claims 1-20 in view of the following.

Rejections under 35 U.S.C. § 102

Group I: Claims 7, 15 and 20

Claims 7, 15 and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated the Graham patent. The Appellant respectfully requests that the Board reverse this rejection in view of the following.

Before discussing at least some of the patentable features of the claimed invention, the Graham patent is introduced.

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The Graham Patent

The Graham patent effectively considers a user's concepts of interest (e.g., from a user profile), advertisers' concepts and concepts of a currently viewed document to target advertising to the currently viewed document. (See, e.g., the Abstract.) More specifically, referring to Figures 1B, 4A and 4B, the Graham patent analyzes a document 100 with respect to user concepts 19 to generate a collection of concepts 20 relevant to the user. (See, e.g., element 102 of Figure 1B and steps 402 and 404 of Figure 4A.) Similarly, the Graham patent analyzes the document 100 with respect to concepts of ads 18 to generate a collection of concepts 22 relevant to ads. (See, e.g., element 104 of Figure 1B and steps 406 and 408 of Figure 4A.) The generated collection of concepts apparently includes a plurality of associated ads. (See, e.g., 22 of Figure 1B.) Finally, the concepts relevant to both the user and the currently viewed document are compared with concepts relevant to both advertisements and the currently viewed document to determine a "best" advertisement. (See, e.g., element 106 in Figure 1B, steps 410 and 412 of Figure 4A and Figure 4B.)

Thus, as can be appreciated from the foregoing, in the Graham patent, advertisements can be retrieved "based upon a determined relevancy between the user's interests, ... the advertiser's concepts and the content of the current document being viewed." Column 5, lines 24-29.

Independent claims 7 and 15 are not anticipated by the Graham patent because the Graham patent does <u>not</u> teach **using document information to determine additional**

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content, using the additional content to determine further content, and combining at least portions of the document, the determined additional content, and the determined further content for presentation to a user. Figure 7 of the present application illustrates an example of document information 710/752, additional content 720/754, and further content 740/756, all combined in document 750.

The Examiner contends that elements 1512 and 1514 of Figure 11A, and column 15, lines 13-19 of the Graham patent teach (1) **using document information to determine additional content,** and (2) **using the additional content to determine further content.** Note that although the Examiner also cited column 6, lines 34-39 of the Graham patent (which discusses the use of highlighted text of document to determine an ad) as teaching document information to determine content, the underpinnings of the Examiner's rejection rely on his assertion that ad 1512 of Figure 11A (which is described as a most relevant ad) is the claimed "determined content." Specifically, the Examiner's rejection relies on his assertion that second ad 1514 of Figure 11A, described on column 15, lines 13-19, teaches the claimed "further content" which was determined using the additional content (which he asserts is taught by ad 1512 of Figure 11A). The Appellant respectfully disagrees with the Examiner's assertion, for reasons demonstrated below.

The cited portions of the Graham patent merely show two ads 1512 and 1514 displayed in an ad space at the right margin of a browser screen 1503. Thus, the cited portions merely show using document content to determine additional content -- **both** ads 1512 and 1514. They do

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not show using the additional content (e.g., ads 1512 and
1514) to determine further content, and combining at
least portions of the document, the determined additional '
content (e.g., ads 1512 and 1514), and the determined
further content for presentation to a user.

In the "Response to Arguments" section of the final
Office Action, the Examiner contends that a second ad
1514 is somehow determined using content of the first ad
1512. Specifically, the Examiner states:

> the *content of* a first ad (1512) is
> selected based upon a relevancy score,
> such that the score is based upon the
> relevancy of *content* of the input
> document, with respect to user
> interests, and advertisement concepts.

Paper No. 20061012, pages 14 and 15. Although the
Appellant notes that the first **ad** (not the content of the
first ad) is selected based on the relevancy of its
content to that of the document and the user, this
assertion is otherwise fairly consistent with the
Appellant's understanding of the Graham patent, as
introduced above. However, the Examiner further states:

> Thus, when the *content of* **the second ad
> (1514) is selected to be broader
> aspect/relevancy than the first
> advertisement** (for which relevancy is
> based upon the relevancy of the
> *content*, as explained previously), then
> the selection based upon known
> relevancy of the first ad, is also
> based upon the *content* of the first ad,
> and thus, the applicant's argument for
> Graham not teaching *using additional
> content to determine further content,*
> is not persuasive. [Bold added.]

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Paper No. 20061012, page 15. As the Appellant will demonstrate, this assertion is neither supported by the Graham patent, nor is it supported by logical reasoning.

Looking first to the Graham patent, the cited portion of the Graham patent states:

> FIG. 11A is an illustration of a representative example of a marketing display area in a web browser according to a particular embodiment of the present invention. This diagram is merely an example which should not limit the scope of the claims herein. One of ordinary skill in the art would recognize many other variations, alternatives, and modifications. FIG. 11A depicts a browser screen 1503 having two advertisement display areas. A first advertisement 1512, for a conference on handheld, ubiquitous computing, and a second advertisement 1514, for the ACM Digital Library are displayed with browser screen 1503. *In this particular example, both advertising display areas 1512 and 1514 display advertisements about a related concept, wearable computers. It is noteworthy that the advertisement displayed in area 1514 is directed to a broader aspect of the underlying concept of wearable computers than the advertisement displayed in area 1512.* These advertisements have been selected using the relevancy determining techniques described herein. However, other embodiments having different concepts in display areas, or different arrangements of display areas, numbers of display areas and the like can be easily created by those of ordinary skill in the art without departing from the scope of the claims. [Emphasis added.]

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Column 15, lines 1-23. The statement that:

> It is noteworthy that the advertisement
> displayed in area 1514 is directed to a
> broader aspect of the underlying
> concept of wearable computers than the
> advertisement displayed in area 1512

(Column 15, lines 13-16) merely notes a characteristic of
the ad in area 1514 as compared with a characteristic of
the ad in area 1512. This statement in no way teaches
(nor does it suggest) somehow **determining** the second ad
in area 1514 (alleged to be the claimed "further
content") **using** the first ad in area 1512 (alleged to be
the claimed "additional content"). With regard to how
the second ad in area 1514 is actually determined, the
Graham patent states, "These advertisements have been
selected using the relevancy determining techniques
described herein." Column 15, lines 16-18. As
introduced above, in the Graham patent, advertisements
can be retrieved "based upon a determined relevancy
between the user's interests, ... the advertiser's
concepts and the content of the current document being
viewed." Column 5, lines 24-29. Nowhere does the Graham
patent teach, either explicitly or inherently, that a
second ad is determined using a first ad, which was
determined using content information, all of which are
displayed to the user.

Further, merely noting that a second ad (selected
using relevancy to a document) is directed to a broader
aspect than a first ad (which was also selected using
relevancy to the document), does not support the

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conclusion that the second ad is determined using the first ad. That is, a description of the relative characteristic of two items does not support the conclusion that one of the two items was determined using the other. The following two simple examples demonstrate this.

In EXAMPLE A, two advertisements are determined from the statement, "Dogs are popular pets."
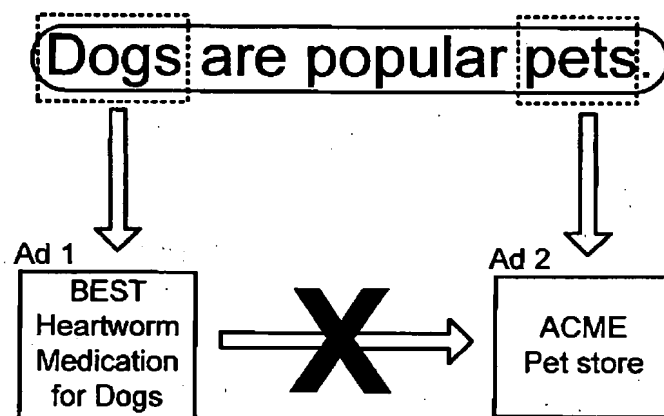
EXAMPLE A

Specifically, Ad 1 was determined using the word "Dogs" and is for a brand of heartworm medication for dogs. Ad 2 was determined using the word "pets" and is for a particular pet store. Ad 1 is directed to a more specific concept than Ad 2. Both ads were determined from different parts of the same source. Although Ad 2 is directed to a broader concept than Ad 1, note that it was not **determined using** Ad 1.

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In EXAMPLE B, a child's relationships are shown. The child's Uncle is the child of the child's Grandparents.
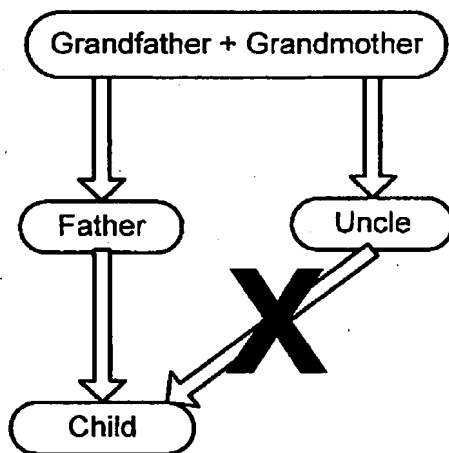
EXAMPLE B

The genes of both the child and the Uncle were "determined from" (as least in part in the case of the child) the genes of the Grandparents. The Uncle is genetically closer to the Grandparents than the Child. However, the relative characteristic (i.e., genetic similarity to the grandparents) between the Uncle and the Child does not support the conclusion that the Child's genes were "determined using" the genes of the Uncle.

As the appellant has demonstrated above, the Examiner's conclusion that the ad in the second area 1514 was determined using the ad in the first area 1512, which is necessary to support his rejection of claims 7 and 15, is supported by neither the teaching of the Graham patent, nor by logical reasoning. Thus, independent claims 7 and 15 are not anticipated by the Graham patent

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for at least the foregoing reason. Since claim 20
depends from claim 7, it is similarly not anticipated by
the Graham patent.

Rejections under 35 U.S.C. § 103

Group II: Claims 1 and 9

Claims 1 and 9 are rejected under 35 U.S.C. § 103(a)
as being unpatentable over the Graham patent. The
appellant respectfully requests that the Board reverse
this rejection in view of the following.

Independent claims 1 and 9, as amended, are not
rendered obvious by the Graham patent because the Graham
patent neither teaches, nor suggests, *using information
of at least one ad to determine information in addition
to the at least one ad, and combining at least a portion
of the at least one ad and the additional information for
presentation to a user together with page content,
wherein the page content is not directly used to
determine the determined content.* Figure 5 of the
present application illustrates an example of ad
information 510, additional content 520, and the ad
content 556 and the additional content 554 combined in
document 550 along with Web page 515 content 552. Notice
that the additional content 554 is determined from the ad
content 510/556, but not directly from the Web page
content 515/552.

As discussed above, the Graham patent teaches using
user concepts, document concepts, and ad concepts to
determine ads to be shown, to the user, with the

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document. *In the Graham patent, the determined ads are* <u>*not*</u> *used to determine information in addition to the ads*.

The Examiner argues that column 4, lines 51-54 of the Graham patent teaches that advertisements are Web page content. (See Paper No. 20061012, page 5.) However, the cited portion of the Graham patent merely notes that ads can be displayed in a user's browser. As shown in Figure 11A, the ads 1512 and 1514 are provided in a portion of the browser screen 1503 separate from the document. This might be to avoid "reformatting the web page". (See, e.g., column 1, lines 42-45.)

In the "Response to Arguments" section of the final Office Action, the Examiner argues that Figure 11C of the Graham patent teaches the use of advertisements embedded into a Web page. (See Paper No. 20061012, page 15.) However, even if the Web page includes embedded advertisements, claims 1 and 9 recite combining at least a portion of the at least one ad and the additional information for presentation to a user *together with page content, wherein the page content is not directly used to determine the determined content*. That is, under the Examiner's proposed combination, the additional content would be *determined using the page content* (i.e., ads embedded on the page) *directly*, whereas the claim requires that this cannot be the case.

The Appellant notes that the Examiner discusses two alternative interpretations of the claimed "page content" (See Paper No. 20061012, page 4.), and provides unconvincing arguments why, under either interpretation, the "page content" is *not directly used to determine the determined content* as claimed (See Paper No. 20061012, page 5.). The Appellant respectfully notes, however,

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that these arguments are directed to the Graham patent **before it is modified** as proposed by the Examiner. That is, when the Graham patent is modified by the Examiner to address the fact that the **ad** document information is used to determine additional content, the Examiner's arguments about interpretations of the "page content" without the proposed modification are no longer valid.

In any event, if the page content is the output page content generated for display and shown in a web browser (the Examiner's first interpretation), such content is <u>not</u> **combined with** at least a portion of the ad document and at least a portion of the determined content as claimed. That is, the Examiner's first interpretation of "page content" is the final output presented to the user, and is therefore not combined with anything. If, on the other hand, the page content is the accepted (ad) document information (the Examiner's second interpretation), such content **is directly used to determine** content combined with the page. The Appellant respectfully disagrees with the Examiner's argument that such information is not **directly** used to determine additional content because user profile information is **also used** in the Graham patent. (See Paper No. 20061012, page 5.) The Examiner is inappropriately equating "directly" with "solely" or "exclusively." This is unlike the case where the page content is not directly used to determine content (which was determined using ad document information) as claimed, an example of which is illustrated in Figure 5 of the present application.

Thus, claims 1 and 9 are not rendered obvious by the Graham patent for at least the foregoing reasons.

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Claims 2, 10 and 17 are rejected under 35 U.S.C.
§ 103(a) as being unpatentable over the Graham patent in
further view of the Bhagavath patent and the Edmunds
page. The Appellant respectfully requests that the Board
reverse this rejection in view of the following.

Group III: Claims 2 and 10

The Bhagavath patent is cited as teaching ad meta
data including display constraints. The cited portion of
the Bhagavath patent concerns using audience
demographics, time and date to constrain the serving of
ads inserted into streaming media. (See, page 6, lines
24-35.)

First, the proposed combination would not compensate
for the deficiencies of the Graham patent with respect to
claims 1 and 9 (of Group II), discussed above, regardless
of the purported scope of the teachings of the Bhagavath
patent and the Edmunds page and regardless of the
presence or absence of motivation to combine. Claims 2
and 10 depend from claims 1 and 9, respectively. Thus,
claims 2 and 10 are not rendered obvious by the cited
references for at least this first reason.

Second, the Edmunds page is cited as showing a
product review in a right hand side of the page.
However, this product review is apparently just a portion
of an authored article. That is, based merely on the
page printout, the Appellant believes that the photo
caption is not **determined using ad information**, but is
simply part of an authored article. In the "Response to
Arguments" section of the final Office Action, the

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Examiner contends that (1) he is only relying on the
Edmunds page to show an ad for a product and additional
content as a product review, and (2) he established that
the Graham and Bhagavath patents include the **capability
to** display determined content based on a least one ad.
(See Paper No. 20061012, page 16.) First, a "capability"
to do something is not a teaching or suggestion to do
actually it. The Bhagavath patent is merely cited as
teaching using audience demographics, time and date to
constrain the serving of ads inserted into streaming
media. This is no way determines content based on an ad,
but rather is used to help determine whether or not to
display the ad. Thus, claims 2 and 10 are not rendered
obvious by the Graham and Bhagavath patents and the
Edmunds page for at least this second reason.

Finally, since the cited art does not suggest the
combination proposed by the Examiner, the proposed
combination is apparently the product of impermissible
hindsight. In the "Response to Arguments" section in the
final Office Action, the Examiner states proper
considerations when making an obviousness determination,
but does not apply them. Specifically, the Examiner
correctly notes that an obviousness analysis should take
into account only knowledge which was within the level of
ordinary skill at the time the invention was made, and
does not include knowledge gleaned only from the
applicants' disclosure. (See Paper No. 20061012, page
17.) However, the Examiner merely concludes that the
combination would have allowed Graham's system to have
been able to provide product review information when the
ad is a product. (See Paper No. 20061012, page 7.)
Where, if not from the applicants' own disclosure, was

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this solution gleaned? If anything, the Graham patent might determine ads related to a product review, but, as established above, determines nothing from ads, let alone product reviews. Consequently, claims 2 and 10 are not rendered obvious by the Graham and Bhagavath patents and the Edmunds page for at least this additional reason.

Group IV: Claim 17

First, since claim 17 depends from claim 2, it is not rendered obvious by the cited patents for at least the reasons discussed above with reference to claim 2 (of Group III).

Second, claim 17 further recites that certain acts are preformed automatically by a machine executing machine-executable instructions. Although the Graham patent can be provided as a computer executing program instructions, the content of the Edmunds page is manually authored, not automatically generated.

Claims 3, 8, 11, 16 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Graham patent in further view of the Bhagavath patent and the CNET page. The Appellant respectfully requests that the Board reverse this rejection in view of the following.

Group V: Claims 3 and 11

As discussed above, the Bhagavath patent is cited as teaching ad meta data including display constraints (e.g., audience demographics, time and date) to constrain

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the serving of ads inserted into streaming media.

First, the proposed combination would not compensate for the deficiencies of the Graham patent with respect to claims 1 and 9 (of Group II), discussed above, regardless of the purported scope of the teachings of the Bhagavath patent and the CNET page and regardless of the presence or absence of motivation to combine. Claims 3 and 11 depend from claims 1 and 9, respectively. Thus, claims 3 and 11 are not rendered obvious by the cited references for at least this first reason.

Second, the CNET page is cited as showing a service review. However, based merely on the page printout, the Appellant believes that the service review is not *determined using ad information*. In the "Response to Arguments" section of the final Office Action, the Examiner contends that (1) he is only relying on the CNETe to show an ad for a service and additional content as a review for the service, and (2) he established that the Graham and Bhagavath patents include the *capability to* display determined content based on a least one ad. (See Paper No. 20061012, page 18.) First, a "capability" to do something is not a teaching or suggestion to do actually it. The Bhagavath patent is merely cited as teaching using audience demographics, time and date to constrain the serving of ads inserted into streaming media. This is no way determines content based on an ad, but rather is used to help determine whether or not to display the ad. Thus, claims 3 and 11 are not rendered obvious by the Graham and Bhagavath patents and the CNET page for at least this second reason.

Finally, since the cited art does not suggest the combination proposed by the Examiner, the proposed

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combination is apparently the product of impermissible hindsight. In the "Response to Arguments" section in the final Office Action, the Examiner states proper considerations when making an obviousness determination, **but does not apply them**. Specifically, the Examiner correctly notes that an obviousness analysis should take into account only knowledge which was within the level of ordinary skill at the time the invention was made, and does not include knowledge gleaned only from the applicants' disclosure. (See Paper No. 20061012, page 19.) However, the Examiner merely concludes that the combination would have allowed Graham's system to have been able to provide a review for a service when the ad is a service. (See Paper No. 20061012, page 9.) Where, if not from the applicants' own disclosure, was this solution gleaned? If anything, the Graham patent might determine ads related to a service review, but, as established above, determines nothing from ads, let alone service reviews. Consequently, claims 3 and 11 are not rendered obvious by the Graham and Bhagavath patents and the CNET page for at least this additional reason.

Group VI: Claim 18

First, since claim 18 depends from claim 3, it is not rendered obvious by the cited patents for at least the reasons discussed above with reference to claim 3 (of Group V).

Second, claim 18 further recites that certain acts are preformed automatically by a machine executing machine-executable instructions. Although the Graham patent can be provided as a computer executing program

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instructions, the content of the CNET page is manually authored, not automatically generated.

Group VII: Claims 8 and 16

First, since claims 8 and 16 depend from claims 7 and 15, respectively, they are not rendered unpatentable by the cited references for at least the same reasons as discussed above with reference to claims 7 and 15 (of Group I) discussed above, regardless of the purported scope of the teachings of the Bhagavath patent and the CNET page and regardless of the presence or absence of motivation to combine. Thus, thus, claims 8 and 16 are not rendered obvious by the cited references for at least this first reason.

Second, the CNET page is cited as showing a service review. However, based merely on the page printout, the Appellant believes that the service review is not **determined using ad information**. In the "Response to Arguments" section of the final Office Action, the Examiner contends that (1) he is only relying on the CNET page to show an ad for a service and additional content as a review for the service, and (2) he established that the Graham and Bhagavath patents include the **capability to** display determined content based on a least one ad. (See Paper No. 20061012, page 18.) First, a "capability" to do something is not a teaching or suggestion to do actually it. The Bhagavath patent is merely cited as teaching using audience demographics, time and date to constrain the serving of ads inserted into streaming media. This is no way determines content based on an ad, but rather is used to help determine whether or not to

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display the ad. Thus, claims 3 and 11 are not rendered obvious by the Graham and Bhagavath patents and the CNET page for at least this second reason.

Third, the service review is not *further information determined from additional content which was determined from document content*. Thus, claims 8 and 16 are not rendered obvious by the Graham and Bhagavath patents and the CNET page for at least this third reason.

Finally, since the cited art does not suggest the combination proposed by the Examiner, the proposed combination is apparently the product of impermissible hindsight. In the "Response to Arguments" section in the final Office Action, the Examiner states proper considerations when making an obviousness determination, *but does not apply them*. Specifically, the Examiner correctly notes that an obviousness analysis should take into account only knowledge which was within the level of ordinary skill at the time the invention was made, and does not include knowledge gleaned only from the applicants' disclosure. (See Paper No. 20061012, page 19.) However, the Examiner merely concludes that the combination would have allowed Graham's system to have been able to provide a review for a service when the ad is a service. (See Paper No. 20061012, page 9.) Where, if not from the applicants' own disclosure, was this solution gleaned? If anything, the Graham patent might determine ads related to a service review, but, as established above, determines nothing from ads, let alone service reviews. Consequently, claims 8 and 16 are not rendered obvious by the Graham and Bhagavath patents and the CNET page for at least this additional reason.

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Claims 4, 12 and 19 are rejected under 35 U.S.C.
§ 103(a) as being unpatentable over the Graham patent and
the Bhagavath patent in further view of the MSN page.
The Appellant respectfully requests that the Board
reverse this rejection in view of the following.

Group VIII: Claims 4 and 12

As already discussed above, the Bhagavath patent is
cited as teaching ad meta data including display
constraints (e.g., audience demographics, time and date)
to constrain the serving of ads inserted into streaming
media. Thus, the proposed combination would not
compensate for the deficiencies of the Graham patent with
respect to claims 1 and 9 (of Group II), discussed above,
regardless of the purported scope of the teachings of the
Bhagavath patent and the MSN page and regardless of the
presence or absence of motivation to combine. Claims 4
and 12 depend from claims 1 and 9, respectively. Thus,
claims 4 and 12 are not rendered obvious by the cited
references for at least this first reason.

The Examiner contends that the MSN page teaches an
ad for a service (MSN messenger) and news about the
service. However, the news is apparently just a portion
of an authored document. That is, based merely on the
page printout, the Appellant believes that the news about
MSN messenger was not **determined using ad information**,
but is simply part of an authored article. In the
"Response to Arguments" section of the final Office
Action, the Examiner contends that (1) he is only relying
on the MSN page to show an ad for a service and
additional content as a news story for the service, and

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(2) he established that the Graham and Bhagavath patents include the **capability to** display determined content based on a least one ad. (See Paper No. 20061012, page 20.) First, as noted above, a "capability" to do something is not a teaching or suggestion to do actually it. The Bhagavath patent is merely cited as teaching using audience demographics, time and date to constrain the serving of ads inserted into streaming media. This is no way determines content based on an ad, but rather is used to help determine whether or not to display the ad. Thus, claims 4 and 12 are not rendered obvious by the Graham and Bhagavath patents and the MSN page for at least this reason.

Finally, since the cited art does not suggest the combination proposed by the Examiner, the proposed combination is apparently the product of impermissible hindsight. In the "Response to Arguments" section in the final Office Action, the Examiner states proper considerations when making an obviousness determination, **but does not apply them.** Specifically, the Examiner correctly notes that an obviousness analysis should take into account only knowledge which was within the level of ordinary skill at the time the invention was made, and does not include knowledge gleaned only from the applicants' disclosure. (See Paper No. 20061012, pages 20 and 21.) However, the Examiner merely concludes that the combination would have allowed Graham's system to have been able to provide a news story about a service when the ad is a service type. (See Paper No. 20061012, page 11.) Where, if not from the applicants' own disclosure, was this solution gleaned? If anything, the Graham patent might determine ads related to a service

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review, but, as established above, determines nothing
from ads, let alone service reviews. Consequently,
claims 4 and 12 are not rendered obvious by the Graham
and Bhagavath patents and the MSN page for at least this
additional reason.

Group IX: Claim 19

First, since claim 19 depends from claim 4, it is
not rendered obvious by the cited patents for at least
the reasons discussed above with reference to claim 4 (of
Group VIII).

Second, claim 19 further recites that certain acts
are preformed automatically by a machine executing
machine-executable instructions. Although the Graham
patent can be provided as a computer executing program
instructions, the content of the MSN page is manually
authored, not automatically generated.

Group X: Claims 5 and 13

Claims 5 and 13 are rejected under 35 U.S.C.
§ 103(a) as being unpatentable over the Graham patent in
further in view of the Bowman patent. The Appellant
respectfully requests that the Board reverse this
rejection in view of the following.

The Examiner cites the Bowman patent as teaching a
search query related to a document as being "determined
content." First, in the Bowman patent, related terms are
suggested to allow a user to refine a search. The
related terms are generated using query term correlation
data, which may be generated and stored in an off-line

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process which processes a query log file. (See, e.g., the Abstract.) Thus, the search query information is not **generated from ad document information** as claimed.

In the "Response to Arguments" section, the Examiner argues that the claimed document is the query correlation data file of the Bowman patent. (See Paper No. 20061012, page 21.) However, the query correlation data file of the Bowman patent is clearly not an ad document, and is not used to determine additional content, as claimed. Furthermore, the ad document, search query, and page content are not combined for presentation to a user. Consequently, claims 5 and 13 are not rendered obvious by the Graham and Bowman patents for at least this reason.

Second, since claims 5 and 13 depend from claims 1 and 9, respectively, they are not rendered unpatentable by the cited references for at least the same reasons as discussed above with reference to claims 1 and 9 (of Group II) discussed above, regardless of the purported scope of the teachings of the Bowman patent and regardless of the presence or absence of motivation to combine. Thus, thus, claims 5 and 13 are not rendered obvious by the Graham and Bowman patents for at least this additional reason.

Finally, since the cited art does not suggest the combination proposed by the Examiner, the proposed combination is apparently the product of impermissible hindsight. In the "Response to Arguments" section in the final Office Action, the Examiner states proper considerations when making an obviousness determination, **but does not apply them.** Specifically, the Examiner correctly notes that an obviousness analysis should take into account only knowledge which was within the level of

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ordinary skill at the time the invention was made, and does not include knowledge gleaned only from the applicants' disclosure. (See Paper No. 20061012, pages 21 and 22.) However, the Examiner merely concludes that the combination would have allowed Graham's system to efficiently locate the most relevant terms. (See Paper No. 20061012, page 12.) However, the Graham patent is concerned with serving relevant advertisements, not helping a user to formulate a search query for a search engine. Helping a user to formulate a search query would not help the functionality related to finding a relevant ad discussed in the Graham patent. Thus, one skilled in the art would not have been motivated to modify the Graham patent as proposed by the Examiner. Consequently, claims 5 and 13 are not rendered obvious by the Graham and Bowman patents for at least this additional reason.

Group XI: Claims 6 and 14

Claims 6 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Graham patent in further view of the Weaver publication. The Appellant respectfully requests that the Board reverse this rejection in view of the following.

The Examiner cites the Weaver publication as teaching a message database that stores messages from a user group. The Weaver publication concerns copying messages from a first forum to a new forum. (See, e.g., the Abstract.) The message is not **generated using ad document information** as claimed. Consequently, claims 6 and 14 are not rendered obvious by the Graham patent and Weaver publication for at least this reason.

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Second, since claims 6 and 14 depend from claims 1 and 9, respectively, they are not rendered unpatentable by the cited references for at least the same reasons as discussed above with reference to claims 1 and 9 (of Group II) discussed above, regardless of the purported scope of the teachings of the Weaver patent and regardless of the presence or absence of motivation to combine. Thus, thus, claims 6 and 14 are not rendered obvious by the Graham patent and Weaver publication for at least this additional reason.

Finally, since the cited art does not suggest the combination proposed by the Examiner, the proposed combination is apparently the product of impermissible hindsight. In the "Response to Arguments" section in the final Office Action, the Examiner states proper considerations when making an obviousness determination, **but does not apply them**. Specifically, the Examiner correctly notes that an obviousness analysis should take into account only knowledge which was within the level of ordinary skill at the time the invention was made, and does not include knowledge gleaned only from the applicants' disclosure. (See Paper No. 20061012, pages 22 and 23.) However, the Examiner merely concludes that the combination would have allowed Graham's system to have messages associated with concepts rather than have ads associated with concepts. (See Paper No. 20061012, page 13.) However, the purpose of the Graham patent is to serve relevant advertisements, not somehow finding user group messages relevant to a document and a user viewing the document. Clearly, one skilled in the art would not have been motivated to modify the Graham patent as proposed by the Examiner in order to destroy its

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primary function. Consequently, claims 6 and 14 are not rendered obvious by the Graham and Weaver patents for at least this additional reason.
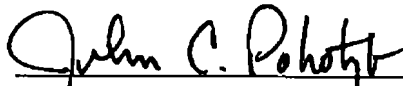

Conclusion

In view of the foregoing remarks, the Appellant respectfully submits that the pending claims are in condition for allowance. Accordingly, the Appellant requests that the Board reverse all outstanding grounds of rejection and direct the Examiner to pass this application to issue.

Any arguments made in this amendment pertain **only** to the specific aspects of the invention **claimed**. Any claim amendments or cancellations, and any arguments, are made **without prejudice to, or disclaimer of**, the Appellant's right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Respectfully submitted,

August 28, 2007

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (and any accompanying paper(s)) is being facsimile transmitted to the United States Patent Office on the date shown below.

John C. Pokotylo
Type or print name of person signing certification

Signature   August 28, 2007
                               Date

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CLAIMS APPENDIX PURSUANT TO
37 C.F.R. § 41.37 (c) (1) (viii)

1   Claim 1 (previously presented): A method comprising:

2   a) accepting ad document information;

3   b) using the ad document information to determine

4   content in addition to content of the ad document; and

5   c) combining at least a portion of content of the ad

6   document and at least a portion of the determined

7   content for presentation to a user together with page

8   content,

9   wherein the ad document is at least one ad, and

10   wherein the page content is not directly used to

11   determine the determined content.

1   Claim 2 (original): The method of claim 1 wherein the at

2   least one ad is for a product and wherein the determined

3   content is a review for the product.

1   Claim 3 (original): The method of claim 1 wherein the at

2   least one ad is for a service and wherein the determined

3   content is a review for the service.

1   Claim 4 (original): The method of claim 1 wherein the at

2   least one ad is for a product or service and wherein the

3   determined content is a news story about the product or

4   service.

1   Claim 5 (original): The method of claim 1 wherein the

2   determined content is a search query related to the

3   document.

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1 Claim 6 (original): The method of claim 1 wherein the
2 determined content is a message from a user group.

1 Claim 7 (previously presented): A method comprising:
2   a) accepting document information;
3   b) using the document information to determine content
4   in addition to content of the document;
5.   c) using the determined content, determining further
6   content; and
7   d) combining at least a portion of content of the
8   document, at least a portion of the determined
9   content, and at least a portion of the determined
10   further content for presentation to a user.

1 Claim 8 (original): The method of claim 7, wherein the
2 determined content is one of (A) a news story, (B) a
3 review, (C) a search query, and (D) a user group message,
4 and

5   wherein the further determined content is at least one
6 ad relevant to the determined content.

1 Claim 9 (previously presented): Apparatus comprising:
2   a) an input for accepting ad document information;
3   b) means for determining content in addition to
4   content of the ad document using the ad document
5   information; and
6   c) means for combining at least a portion of content
7   of the document and at least a portion of the
8   determined content for presentation to a user together
9   with page content,
10   wherein the ad document is at least one ad, and

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11   wherein the page content is not directly used to
12   determine the determined content.

1   Claim 10 (original):   The apparatus of claim 9 wherein the
2   at least one ad is for a product and wherein the determined
3   content is a review for the product.

1   Claim 11 (original):   The apparatus of claim 9 wherein the
2   at least one ad is for a service and wherein the determined
3   content is a review for the service.

1   Claim 12 (original):   The apparatus of claim 9 wherein the
2   at least one ad is for a product or service and wherein the
3   determined content is a news story about the product or
4   service.

1   Claim 13 (original):   The apparatus of claim 9 wherein the
2   determined content is a search query related to the
3   document.

1   Claim 14 (original):   The apparatus of claim 9 wherein the
2   determined content is a message from a user group.

1   Claim 15 (previously presented):   Apparatus comprising:
2   a) an input for accepting document information;
3   b)   means for determining content in addition to
4   content of the document using the document
5   information;
6   c) means for determining further content using the
7   determined content; and
8   d) means for combining at least a portion of content
9   of the document, at least a portion of the determined

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10   content, and at least a portion of the determined
11   further content for presentation to a user.

1   Claim 16 (original): The apparatus of claim 15, wherein
2   the determined content is one of (A) a news story, (B) a
3   review, (C) a search query, and (D) a user group message,
4   and
5   wherein the further determined content is at least one
6   ad relevant to the determined content.

1   Claim 17 (previously presented): The method of claim 2,
2   wherein the acts of (b) using the ad document information
3   to determine content in addition to content of the ad
4   document, and (c) combining at least a portion of content
5   of the ad document and at least a portion of the determined
6   content for presentation to a user together with page
7   content, are performed automatically by a machine executing
8   machine-executable instructions.

1   Claim 18 (previously presented): The method of claim 3,
2   wherein the acts of (b) using the ad document information
3   to determine content in addition to content of the ad
4   document, and (c) combining at least a portion of content
5   of the ad document and at least a portion of the determined
6   content for presentation to a user together with page
7   content, are performed automatically by a machine executing
8   machine-executable instructions.

1   Claim 19 (previously presented): The method of claim 4,
2   wherein the acts of (b) using the ad document information
3   to determine content in addition to content of the ad
4   document, and (c) combining at least a portion of content

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5   of the ad document and at least a portion of the determined
6   content for presentation to a user together with page
7   content, are performed automatically by a machine executing
8   machine-executable instructions.

1   Claim 20 (previously presented): The method of claim 7,
2   wherein the acts of (b) using the document information to
3   determine content in addition to content of the document,
4   (c) using the determined content, determining further
5   content, and (d) combining at least a portion of content of
6   the document, at least a portion of the determined content,
7   and at least a portion of the determined further content
8   for presentation to a user, are performed automatically by
9   a machine executing machine-executable instructions.

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EVIDENCE APPENDIX PURSUANT TO
37 C.F.R. § 41.37 (c) (1) (ix)

There is no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132, nor is there any other evidence entered by the Examiner and relied upon by the appellant in the appeal.

RELATED PROCEEDINGS APPENDIX PURSUANT
TO 37 C.F.R. § 41.37 (c) (1) (x)

There are no decisions rendered by a court of the
Board in any proceeding identified in section II of the
Appeal Brief pursuant to 37 C.F.R. § 41.37 (c) (1) (ii).